



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,220	04/09/2004	Semyon B. Mizakovsky	2100.006100	1318
7590 11/13/2009				
Terry D. Morgan Williams, Morgan & Amerson, P.C. Suite 1100 10333 Richmond Houston, TX 77042			EXAMINER PARTHASARATHY, PRAMILA	
			ART UNIT 2436	PAPER NUMBER
			MAIL DATE 11/13/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/822,220

**Applicant(s)**

MIZIKOVSKY, SEMYON B.

**Examiner**

PRAMILA PARTHASARATHY

**Art Unit**

2436

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the communication 06/24/2009. Claims 1 – 11 are currently pending.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1 – 11 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 – 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over
  - a. claims 1 – 34 of Patent 5,943,425
  - b. claims 1 – 18 of Patent 6,950,521

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims recite "receiving a CHAP challenge; deriving a RAND challenge based on at least a portion of the CHAP challenge; performing an authentication and deriving a secret CHAP key", where as the copending claims recite "receiving a first message; determining a second message based upon the first message and a first key known to the server network ...wherein the first key is generated during the establishment of the security association; providing the second message to the server network; wherein receiving the first message from the mobile shell comprises receiving the first message in response to a challenge interrogation message provided by the server network; wherein receiving the first message comprises receiving a random number provided by the server network". Claim(s) of Patent contain(s) every element of claim(s) 1 – 11 of the instant application and thus anticipate the claim(s) of the instant application. Claim(s) of the instant application therefore is/are not patently distinct from the earlier patent claim(s) and as such is/are unpatentable over obviousness-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a 35 patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

"Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf, Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982).

Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29 USPQ2d 1010 (12/3/1993))

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed toward software per se, which is not recognized as conforming to any of the classes of statutory subject matter: see *In re Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760.

Examiner suggests amending the claims to overcome the rejection by storing the program/instructions on to a computer readable medium that would correspond a physical computer element that defines structural and functional requirements between the computer program and the rest of the computer which allow the computer program's functionality to be realized. See *In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

***Claim Objections***

5. Claims 2 – 6 and 11 are objected to because of the following informalities: Expand all acronyms. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1 recites “authenticating a user identity module implemented in access terminal ...”, however do not show how that authentication is achieved.

Examiner suggests amending the independent claims with the subject matter that is disclosed in instant specification paragraph [0030-0031 and 0033 – 0035].

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Robles et al. (Publication 2005/0251681).

8. As per Claims 1, Robles teaches "receiving, at the access terminal and over an air interface, a first challenge associated with a first authentication process (paragraph [0090]);  
deriving, at the access terminal, a second challenge associated with a second authentication process based on at least a portion of the first challenge (paragraph [0103];  
performing, at the user identity module, the second authentication process using the derived second challenge and producing at least one authentication parameter therefrom; and  
deriving, at the access terminal, a key associated with the first authentication process based on the at least one authentication parameter (paragraph [0146])."
9. As per Claims 2 – 7 and 11, Robles teaches "receiving a CHAP challenge (paragraph [0090]);  
deriving a RAND challenge based on at least a portion of the CHAP challenge (paragraph [0103]);  
performing an authentication using the RAND challenge to produce a SMEKEY and a PLCM; and deriving a secret CHAP key based on the SMEKEY and PLCM" (paragraph [0146]).
10. As per Claims 8, Robles teaches "further comprising generating, at the access terminal, an authentication response based on the key; and delivering the authentication response over the air interface to a network to request access to the network" (paragraph [0061 and 0105]).
11. As per Claims 9, Robles teaches "determining that the first challenge associated with the first authentication process is a re-authentication challenge; bypassing the derivation of the second challenge associated with the second authentication process based on at least a portion

of the first challenge in response to the determining that the first challenge is the re-authentication challenge; bypassing the performance of the second authentication process using the derived second challenge and producing at least one authentication parameter therefrom in response to the determining that the first challenge is the re-authentication challenge; and wherein deriving the key associated with the first authentication process based on the at least one authentication parameter further comprises using a previously derived key in response to the determining that the first challenge is the re-authentication challenge" (Fig.6 and 7; associated text).

12. As per Claims 10, Robles teaches "determining that the first challenge associated with the first authentication process is a re-authentication challenge; and wherein delivering the key to a network to request access to the network further comprises delivering a previously derived key in response to the determining that the first challenge is the re-authentication challenge" (Fig.6 and 7; associated text).

### ***Conclusion***

Examiner's Note: Please note the change in the Examiner.

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.



The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRAMILA PARTHASARATHY whose telephone number is (571)272-3866. The examiner can normally be reached on 8:00a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.